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10/615,832	07/10/2003	Yoshifumi Tanimoto	030733	8885

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EXAMINER	
FRINK, JOHN MOORE	

ART UNIT	PAPER NUMBER
2142	

MAIL DATE	DELIVERY MODE
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/615,832	TANIMOTO, YOSHIFUMI	
	Examiner	Art Unit	
	John M. Frink	2142	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☐ Responsive to communication(s) filed on _____.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) 1-26 is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) 1-26 is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date 7/10/2003,9/27/2005,12/01/2005.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 1, 4, 7, 9, 11, 15, and 16 are rejected under 35 U.S.C. 102(b) as being anticipated by Chang et al. (US 6,292,825 B1).

3. Regarding claims 1 and 16, Chang et al. disclose a mailbox which stores received electronic mail by corresponding each of the electronic mail and an electronic mail address of a destination; means for transmitting electronic mail of a new mail notification to the electronic mail address of the destination of a received electronic mail by a push method protocol; and means for distributing the electronic mail by a pull method protocol in accordance with a distribution request from the electronic mail address of the destination of the electronic mail stored in the mailbox (Fig. 4, Fig. 5, col. 4 line 30 – col. 5 line 30).

4. Regarding claim 4, Chang et al. disclose where when the electronic mail address of the destination of the received electronic mail is an electronic mail address designated in advance, the means for transmitting transmits electronic mall of a new mail notification by the push method protocol (col. 4 line 30 – col. 5 line 30).

5. Regarding claim 7, Chang et al. disclose where the means for transmitting determines whether or not to transmit the electronic mail of the new mail notification by

the push method protocol in accordance with a type of the received electronic mail (col.4 line 30 – col. 5 line 2).

6. Regarding claim 9, Chang et al. disclose where the means for transmitting determines not to transmit the electronic mail of the new mail notification by the push method protocol when the received electronic mail is an electronic mail not attached with an attached file (col. 4 line 30 – col. 5 line 2).

7. Regarding claim 11, Chang et al. disclose where in the means for transmitting transmits the electronic mail of the new mail notification by the push method protocol when the type of the received electronic mail is an electronic mail of a type designated in advance (col.4 lines 30 – 67).

8. Regarding claim 15, Chang et al. disclose the means for transmitting notifies an amount of data of the received electronic mail by electronic mail of a new mail notification (col. 4 lines 60 - 67).

9. Claims 1, 4, 5 and 16 rejected under 35 U.S.C. 102(b) as being anticipated by Boyle et al. (6,119,167).

10. Regarding claims 1 and 16, Boyle et al. disclose a mailbox which stores received electronic mail by corresponding each of the electronic mail and an electronic mail address of a destination; means for transmitting electronic mail of a new mail notification to the electronic mail address of the destination of a received electronic mail by a push method protocol; and means for distributing the electronic mail by a pull method protocol in accordance with a distribution request from the electronic mail address of the destination of the electronic mail stored in the mailbox (col. 6 line 57 – col. 7 line 14).

11. Regarding claim 4, Boyle et al. disclose where when the electronic mail address of the destination of the received electronic mail is an electronic mail address designated in advance, the means for transmitting transmits electronic mall of a new mail notification by the push method protocol (col. 6 line 62 – col 7 line 14, col. 11 lines 47 – 52).

12. Regarding claim 5, Boyle et al. disclose means for registering whether or not to carry out the new mail notification to each of a plurality of electronic mail addresses; wherein the means for transmitting determines whether or not to carry out a new mail notification in accordance with registered contents of the means for registering (col. 11 line 59 – col. 12 line 10).

Claim Rejections - 35 USC § 103

13. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

14. Claims 2, 3, 6, 8, 10, 17, 18,19 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chang et al. in view of Wakasugi et al. (US 6,823,367 B1).

15. Regarding claims 2, 6, 10 and 17, Chang et al. disclose mail server and mail receiving terminal devices according to claims 1, 4, 7 and 17.

Change et al. do not disclose where the push method protocol is SMTP.

Wakasugi et al. disclose utilizing SMTP (col. 5 lines 30 – 35, col. 6 lines 58 – 65, col. 17 lines 1 – 10).

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify the disclosure of Chang et al. with that of Wakasugi et al. in order to utilize an industry standard mail protocol.

16. Regarding claims 3 and 18, Chang et al. disclose mail server and mail receiving terminal devices according to claims 1 and 16.

Change et al. do not disclose where the pull method protocol is POP.

Wakasugi et al. disclose POP (col. 5 lines 35 – 38, col. 6 lines 58 – 65, col. 17 lines 1 – 10).

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify the disclosure of Chang et al. with that of Wakasugi et al. in order to utilize an industry standard mail protocol.

17. Regarding claim 19, Chang et al. disclose the mail receiving terminal device according to claim 16.

Change et al. do not disclose a printing unit which prints the received electronic mail as a hardcopy; wherein the means for requesting requests the mail server to distribute electronic mail by the pull method protocol when the printing unit can execute a printing operation, and when the new mail notification is received.

Wakasugi et al. disclose a printing unit which prints the received electronic mail as a hardcopy; wherein the means for requesting requests the mail server to distribute electronic mail by the pull method protocol when the printing unit can execute a printing

operation, and when the new mail notification is received (col. 7 lines 35 – 40, col. 9 lines 11 –54, col. 30 - 35).

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify the disclosure of Chang et al. with that of Wakasugi et al. in order to provide a easily portable, achievable copy of electronic communications.

18. Regarding claim 20, Chang et al. in view of Wakasugi et al. further disclose where the pull method protocol is a Post Office Protocol (POP) (Wakasugi et al., col. 5 lines 35 – 38, col. 6 lines 58 – 65, col. 17 lines 1 – 10).

19. Regarding claim 8, Chang et al. disclose the mail server according to claim 7, including setting a priority for which types of emails notifications should be sent (col. 4 lines 30 – 65, col. 5 lines 20 - 27).

Chang et al. do not disclose not transmitting the electronic mail of the new mail notification by the push method protocol when the received electronic mail is a reception confirmation mail of electronic mail transmitted previously.

Wakasugi et al. disclose the receivers of an email sending delivery confirmation messages to the senders of said email.

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify the disclosure of Chang et al., involving not pushing notifications to users regarding messages that are not a high priority as defined by said user, with that of Wakasugi et al., which lets a sender of an email knows when the message the sent has been received so that the status important messages could be verified, in order to enable a user of Chang et al's disclosure to keep the capability to not receive

notifications of new messages that are not of a high priority to said user, as receiving confirmation emails would otherwise result in a large increase of new email notifications (an additional email received for every email sent).

20. Claims 12, 13 and 14 rejected under 35 U.S.C. 103(a) as being unpatentable over Chang et al. in view of Beyda et al. (US 6,275,850 B1).

21. Regarding claim 12, Chang et al. disclose the mail server according to claim 11, wherein the means for transmitting transmits the electronic mail of the new mail notification by the push method protocol, in addition to allowing the user to elect whether or not they want mail attachments pushed to them (col. 4 lines 16 – col. 5 line 30).

Chang et al. do not disclose where pushing the attachment when the received electronic mail is an electronic mail which a file of a prescribed type is attached as an attached file.

Beyda et al. disclose where pushing the attachment when the received electronic mail is an electronic mail which a file of a prescribed type is attached as an attached file (Fig. 3, col. 3 lines 1 – 14).

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify the disclosure of Chang et al. with that of Beyda et al. in order to allow the user to more accurately specify which emails they would like pushed to them in order to save the user the time spent downloading the attachments and well as the cost of the bandwidth utilized to download said attachments.

22. Regarding claim 13, Chang et al. in view of Beyda et al. disclose claim 12.

Chang et al. in view of Beyda et al. do not disclose where the prescribed type is an image file or a file in a format converted into character data from the image.

It would have been obvious to one of ordinary skill in the art to process/consider files where the prescribed type is an image file or a file in a format converted into character data from the image as said file types are commonly emailed as attachments.

23. Claim 14 is rejected under 35 U.S.C. 103(a) as being unpatentable over Chang et al. in view of Beyda et al. as applied to claim 11 above, and further in view of Wakasugi et al.

Chang et al. in view of Beyda et al. disclose the method of claim 11.

Chang et al. in view of Beyda et al. do not disclose where the push method protocol is SMTP.

Wakasugi et al. disclose utilizing the push method protocol SMTP (col. 5 lines 30 – 35, col. 6 lines 58 – 65, col. 17 lines 1 - 10).

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify the disclose of Chang et al. in view of Beyda et al. with that of Wakasugi et al. in order to utilize the industry standard push method protocol SMTP.

24. Claims 21, 23 and 25 rejected under 35 U.S.C. 103(a) as being unpatentable over Beyda et al.

25. Regarding claim 21, Beyda et al. disclose the method according to claim 16, along with means for storing the received electronic mail and where the means for requesting request the mail server to distribute the electronic mail by the pull method

protocol when the mail satisfies a maximum size requirement (Fig. 3, col. 2 line 51 – col. 3 line 14).

Beyda et al. does not disclose where the size requirement relates to the available storage capacity.

It would have been obvious to one of ordinary skill in the art at the time of the invention to consider available storage capacity before when determining whether or not to request an email based on the emails size as it is pointless to attempt to download an email when you do not have space to complete the download operation.

26. Regarding claim 23, Beyda et al. further disclose means for storing the received electronic mail and means for comparing an amount of data notified by the received electronic mail of the new mail notification (Fig. 3, col. 2 line 51 – col. 3 line 14).

Beyda et al. does not disclose comparing said size of said email with an available capacity in the means for storing when the new mail notification is received; wherein the means for requesting requests the mail server to distribute the electronic mail by the pull method protocol when the amount of data notified by the new mail notification is smaller than the available capacity in the means for storing.

It would have been obvious to one of ordinary skill in the art at the time of the invention to first determine whether or not new mail can be stored before requesting it be sent to you when calculating whether or not to request email based on a size requirement, as disclosed by Beyda et al., as it is pointless to attempt to download an email when you do not have space to complete the download operation.

27. Regarding claim 25, Beyda et al. further disclose means for storing the received electronic mail; and means for comparing an amount of data notified by the received electronic mail of the new mail notification, and a prescribed amount when the new mail notification is received; wherein the means for requesting requests the mail server to distribute the electronic mail by the pull method protocol when the amount of the data notified by the new mail notification is smaller than the prescribed amount (Fig. 3, col. 2 line 51 – col. 3 line 14).

28. Claims 22, 24 and 26 rejected under 35 U.S.C. 103(a) as being unpatentable over Beyda et al. in view of Wakasugi et al.

Beyda et al. discloses the devices according to claims 21, 23 and 25.

Beyda et al. does not disclose where said devices utilize the pull method protocol POP.

Wakasugi et al. disclose utilizing the pull method protocol POP.

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify the disclose of Beyda et al. with that of Wakasugi et al. in order to utilize POP, an industry standard protocol for sending email.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to John M. Frink whose telephone number is (571)272-9686. The examiner can normally be reached on M-F 7:30AM - 5:00PM EST; off alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew Caldwell can be reached on (571)272-3868. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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